

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application. Claims 1, 2, 4 and 6-11 remain in the application and claims 1 and 9 are independent.

The Office Action dated December 10, 2008 has been received and carefully reviewed. Each issue raised in the Office Action is addressed below. Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks.

Legal Standard for Anticipation and Obviousness Rejections

According to MPEP §2131, “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ...claims.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913 (Fed. Cir. 1989).

Similar to anticipation rejections, in order to establish a *prima facie* case of obviousness, the prior art references must teach or suggest all the claim limitations. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” (See In Re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006).

Claim Rejections – 35 U.S.C. §102

Claims 1 and 9 stand rejected under 35 U.S.C. § 102(e) as unpatentable over U.S. Pat. No. 6,522,354 to Kawamura et al. (“Kawamura”). Applicants submit that the Examiner has failed to establish a *prima facie* case of anticipation and respectfully traverse the rejection. A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

In order to establish a *prima facie* case of anticipation under 35 U.S.C. § 102, the cited reference must teach or inherently include each and every element of the claims. In addition to the above, see *M.P.E.P.* § 706.02.

While not conceding the appropriateness of the Examiner's rejection, but merely to advance prosecution of the instant application, Applicants respectfully submit that independent claim 1 has been amended to recite a combination of elements in a digital camera including the digital image data for which said printing-specifying information was set and digital image data with no printing-specifying information are discriminated from each other when they are displayed at the same time on said displaying means prior to the digital image data being read out of the storage medium for printing. Applicants respectfully submit that this combination of elements as set forth in independent claim 1 is not disclosed or made obvious by the prior art of record, including Kawamura.

The Examiner states that Kawamura shows display means 19 in Figures 2 and 3, printing-specifying information setting means 35, 36 and 37 for setting printing-specifying information as described in column 5, lines 31-56, and control means for displaying digital image data for which printing-specifying information was set so that digital image data shows on the display with and without printing-specifying information as described at column 6, lines 12-58, which describe the addition of the telephone icon 51 and the PC icon 52 to the thumbnail image of the transferred image.

Applicants respectfully submit to the contrary, the icons 51 and 52 indicating successful transfer of the image data are only applied after successful transfer of the image data. Prior to transfer of the image data, column 5, lines 42-48, indicate that upon confirmation by switch 37 of the selection of recorded items to be transferred, the "microcomputer 15 then serially adds pointer information of the selected items of recorded information to a transfer list provided in the memory 24 (step S4)" (emphasis added). Clearly, Kawamura does not add printing-specifying information to the thumbnail images displayed on the display 19 prior to the digital image data being read out of the storage medium for printing as now claimed. Likewise, independent claim 9 has been amended to recite a combination of elements in a method of operating a display of a digital camera, such that a digital image for which said printing-specifying information was set

and a digital image without printing-specifying information are discriminated from each other prior to the digital image being read out of the digital camera for printing. Applicants respectfully submit that the combination of elements as set forth in independent claims 1 and 9, as now amended, is not disclosed or made obvious by the prior art of record, including Kawamura, for the reasons explained above. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Claim Rejections – 35 U.S.C. § 103, including Honda

Claims 2, 6, 7, 10 and 11 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Kawamura in view of U.S. Pub. No. 2004/0201764 to Honda et al. (“Honda”). Applicants submit the Examiner has failed to establish a *prima facie* case of obviousness and respectfully traverse the rejection. A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the cited references must teach or suggest each and every element in the claims. *See M.P.E.P. § 706.02(j); M.P.E.P. 2141-2144.*

Honda has been cited to show printing-specifying information, such as a number of print sheets, displayed with the recorded image on the camera display as appears in Figures 30A, 30C, 31, 32A and 32B. To the contrary, we note that Honda only discloses presenting a full frame image with all of the printing-specifying information for every image. Honda never discloses or suggests displaying digital image data of a number of thumbnail images at the same time in the camera display. Honda never discloses or suggests displaying images for which printing-specifying information was set and digital image data with no printing-specifying information so they may be discriminated from each other when they are displayed at the same time on said displaying means prior to the digital image data being read out of the storage medium for printing, and therefore Honda cannot remedy the defects of Kawamura discussed above. The secondary reference to Honda neither discloses nor suggests simultaneous display of both kinds of images prior to the image data being read out of the storage medium, as recited in amended claims 1 and 9, from which claims 2, 6, 7, 10 and 11 depend. Accordingly, the Office Action

fails to make out a *prima facie* case of obviousness of the subject matter recited in currently pending claims 1, 2, 7 and 9-11.

Claim Rejections - 35 U.S.C. §103, including Hanzawa

Claims 4/1 and 8 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Kawamura in view of U.S. Pat. No. 5,506,661 to Hanzawa. Claim 4/2 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Kawamura in view of Honda and Hanzawa.

Hanzawa was cited for showing a display of only the printing-specifying data on the display and for displaying a printing price value on the display. To the contrary, we note that Hanzawa is not directed to the display on a digital camera as claimed, but to the display on a mimeographic production printing apparatus as show in Figure 1 and as described in column 3, lines 15-22 and column 4, lines 33-39. Hanzawa merely calculates and displays the price for a mimeograph order using the apparatus in Figure 3 and the flow chart of Figure 4. Hanzawa provides no teachings or suggestions related to images stored in a digital camera. Hanzawa does not supply the missing features of claim 1 that are lacking from Kawamura. Moreover, it is not clear how one might combine the disclosures of Kawamura and Hanzawa since Hanzawa is not directed to a digital camera at all, but is instead directed to the display for a mimeographic printing apparatus. Such an apparatus cannot display a digital photograph at all and can only display print control parameters. The rejection is silent as to what would create a nexus that would connect such disparate prior arts. Claims 4 and 8 are additionally submitted to be allowable for the reasons set forth above regarding claim 1 for the further features claimed therein.

Conclusion

All objections and rejections raised in the Office Action having been properly traversed and addressed, it is respectfully submitted that the present application is in condition for allowance. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been

made to the outstanding Office Action, and as such, the present application is in condition for allowance. Notice of same is earnestly solicited.

Prompt and favorable consideration of this Amendment is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Paul T. Sewell, Registration No. 61,784, at (703) 205-8000, in the Washington, D.C. area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.14; particularly, extension of time fees.

Dated: March 6, 2009

Respectfully submitted,

By 

D. Richard Anderson

Registration No.: 40,439

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant